APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,898	06/23/2003	Kathiravan Sengodan	BEAS-01351US2	7557

23910 7590 11/20/2006	EXAMINER
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111	STEELMAN, MARY J

	ART UNIT	PAPER NUMBER
	2191	

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/601,898	SENGODAN, KATHIRAVAN
	Examiner	Art Unit
	Mary J. Steelman	2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *6/23/03, 9/26/03*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-20* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on *23 June 2003* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/26/2003*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   Clams 1-20 are pending.

Information Disclosure Statement

2.   IDS received 09/28/2003 has been considered.

Specification

3.   The use of the trademarks, JAVA/JMS/JMX/JMSML, has been noted in this application.

It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary

nature of the marks should be respected and every effort made to prevent their use in any manner

which might adversely affect their validity as trademarks.

Examiner requests Applicant to fill in the blank lines of page 1 of the Specification.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5.   Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

See MPEP 7.35.01 Trademark or Trade Name as a Limitation in the Claim

Claims 1, 8, 10, 11, 18, and 20 contain the trademark/trade name JAVA (JMS / JMX). Where a

trademark or trade name is used in a claim as a limitation to identify or describe a particular

material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second

paragraph. See Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is

uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe byte code programming language and, accordingly, the identification/description is indefinite.

The trademark JMS/JMX is improperly relied upon in the claims to incorporate the technical features of a particular programming language environment. However, the trademark JMS/JMX can only properly define the source of the programming language environment, namely Sun Microsystems, Inc. Accordingly, the identification/description is indefinite.

Sun Microsystems, Inc. is the sole producer and/or licenser of JAVA products. The trademark JAVA identifies the source of the products and not the products themselves. In contrast, for example, C++ is a name used in trade to identify a particular nonproprietary programming language conforming to an accepted standard. Products and services incorporating the name C++ are produced by numerous sources. Further, the technologies identified using the trademark JAVA are continuously evolving. An example of this evolution can be found in "JSR 14: Add Generic Types To The Java™ Programming Language", which describes a proposed amendment to the JAVA Language Specification submitted by Sun Microsystems, Inc., in 1999 and pending approval by the JAVA COMMUNITY PROCESS Program. In view of the statements presented above, it is asserted that the trademark JAVA has no fixed definite technical meaning.

Accordingly, a rejection under 35 U.S.C. 112, second paragraph, based on the use of the

trademark JAVA as a limitation in a claim, is proper.

Double Patenting

6.   The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined

application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may

be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the

scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7.   Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/602037, 10/602038, and 10/601929. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

In the instant application, 10/601898, claims 1-20 are directed towards a user entering markup languages and communicating to a remote server whereby a command processor converts the markup language into JMS or JMX system operations.

As an example:

10/602037 Claims 1-10 are directed towards accessing JMS using a markup language, a source file containing markup language, parsing and communicating to a command processor and converting the markup language into JMS or JMX system operations.

10/602038 Claims 1-18 are directed towards a user editing and modifying markup language programs that access JMS interfaces, parsing and communicating to a command processor, and a command processor that converts the markup language components into JMS or JMX system operations.

10/601,929, claims 1-14 are directed towards a user entering markup language components, a

command processor that converts the markup language into JMS or JMX system operations, and

communicates said markup language components to a server.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent

Application Publication 2003/0177477 A1 to Fuchs, in view of US Patent 6,753,889 B1 to

Najmi.

Per claim 1:

A system including a web-based interface for use with a JMS mark-up language, comprising:

-a web application including a user interface that executes on a client machine and allows a user

to enter markup language components and communicate said markup language components to a

remote server for processing thereon;

Fuchs: FIG. 1, #1110, FIG. 5, #502,FIG. 7, #2502 & #2543. [0063]-graphical use interface

builder. [0178-0202]-"The proposed tool may comprise:...XML...generate a XML mapping

description for each MIB (520)" [0189]-"Alternatively, it may use sets of XML descriptors, as

defined for such Mbeans in the JMX specification. See FIG. 9 and related text at [0313]

regarding preparation for communicating with a remote server (map source to target).

Najmi: See FIG. 2 Web technology including a JAVA Server Page, dynamic content, a server

and client. Col. 5: 8-11, an e-customer generates a purchase order (PO) which is communicated

to a remote e-business server. The template that a client uses to generate a purchase order is

XML elements (col. 6:15).

-a command processor that executes at a remote server and converts the markup language

components into one of JMS or JMX system operations.

Fuchs failed to explicitly disclose JMS (JAVA messaging service):

However, Najmi disclosed:

(FIG. 2 & related text at col. 6, line 3) a client / server environment and XML elements. As an

example, (col. 6, lines 28-32) "If the EJB 204-2 determines that additional chip sets are required,

then a command requesting additional (command processor converts XML to JMS) chipsets...is

sent to an appropriate Topic in the JAVA Message Service (JMS) API 206." Additional

discussion related to converting to JMS is found at col. 8, lines 32-50.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the

invention to modify Fuchs' invention, using the teachings of Najmi because both inventions are

directed towards transparent protocols (Fuchs: [0004] & Namji: col. 2:12-22) for enterprise

messaging using JAVA.

Per claim 2:

-the markup language components are communicated as a source file, and wherein the remote

server includes a parser that parses said source file to retrieve said markup language components

and communicate said markup language components to said command processor.

Fuchs failed to provide explicit details regarding the remote server.

However, Najmi disclosed (FIG. 2 and col. 6: 3-15), "...e-business 102 includes a client API 202

that includes a servlet and a JAVA Server Page (JSP)...an extensible Web technology that uses

template data, custom elements, scripting languages, and server-side Java objects to return

dynamic content to a client. Typically the template data is HTML or XML elements..." Col. 8:

35-45, "partner adapter servlet 420 capable of receiving the acknowledgement 116 in the form

of, for example, XML (markup language components communicated). Based upon a delivery

rule retrieved from the B2B contract database 406, the partner adapter servlet 420 directs an

appropriate delivery message adapter 422 to reformat (adapter servlet directs message adapter /

command processor) the acknowledgement 116 into a form consistent with what is

expected...capable of converting an XML based document into a JAVA based document, or in

some cases, to another XML document…"

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the

invention to modify Fuchs' invention, using the teachings of Najmi because both inventions are

directed towards transparent protocols (Fuchs: [0004] & Namji: col. 2:12-22) for enterprise

messaging using JAVA.

Per claim 3:

-said user interface includes a file selection device for selecting a source file to be communicated

to said command processor.

Fuchs: See FIG. 5 and related text at [0178-0184], "The proposed tool may comprise: A series

of front-ends 502 for loading class information form standard Mbeans, by JAVA introspection

(501-1) from CIM (Common Information Model), e.g.MOF (Managed Object Format) or XML

CIM (501-2)…A user interface 502 that will issue commands…" [0235]-"The mapping engine

will take this command file as input, load the appropriate classes…"

Per claim 4:

-said user interface includes a Web-based form within which a user can enter markup language

commands to be communicated to said command processor.

Fuchs: See FIG. 5 and related text at [0267-0278]-"Such a GUI may implement some or all of

the following user input functionalities: Graphically load new classes, create new SNMP

MIBx...graphically map...graphically tune the proposed default mapping: choose new

values...choose custom names... (user interface with Web based form)"

Per claim 5:

-said web application is a web browser.

Fuchs: See FIG. 5, #502, FIG. 7, #2502 & #2543 [0103]-"web browser 1110..."

Per claim 6:

-said web application communicates said markup language components to said remote server via

a wide area network or the Internet.

Fuchs: [0111]-"The management level may use various management technologies, e.g. SNMP,

CMIP, CORBA, WBEM, etc...(communication technologies used on the internet)"

Per claim 7:

-wherein said parser and said command processor comprise an engine that parses source files and

generates commands.

Fuchs: As an example, see [0305-0307]-"A user input 800 e.g. the command file of EX1 is

considered...For each command: operation 804 parses the current command, extracts its

parameters and invokes command handler as necessary...for a generate operation 840 may

generate the specified output (generate commands)..."

Per claim 8:

-wherein the markup language is JMS markup language.

Fuchs disclosed messaging tools: [0128]-"An SNMP Agent toolkit, allowing to implement JMX SNMP Agents. The SNMP Agent toolkit comprises an SNMP adaptor 2103 and an SNMP MIB compiler 2104."(JAVA messaging services) [0215]-JDMK (JAVA Dynamic Management Kit).

Fuchs failed to explicitly disclose JMS.

However, Najmi disclosed JMS at col. 3: 54.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention to modify Fuchs' invention, using the teachings of Najmi because both inventions are directed towards transparent protocols (Fuchs: [0004] & Namji: col. 2:12-22) for enterprise messaging using JAVA.

Per claim 9:

-wherein the source file is an XML file.

Fuchs: [0158]

Per claim 10:

-wherein the markup language is JMS markup language.

Fuchs disclosed messaging tools: "The proposed solution using XML or a similar language gives the following advantages: It is extensible...Also, it may be based on existing components:

XML parser code is available...existing code can parse an SNMP MIB, and build its syntax tree. The mibgen component of JDMK includes such a functionality...existing code perform introspection of Mbeans to obtain an MbeanInfo structure. The proxygen component of JDMK includes such a functionality..."

Fuchs failed to explicitly disclose JMS.

However, Najmi disclosed JMS at col. 3: 54.

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time of the invention to modify Fuchs' invention, using the teachings of Najmi because both inventions are directed towards transparent protocols (Fuchs: [0004] & Namji: col. 2:12-22) for enterprise messaging using JAVA.

Per claims 11-20:

These are method version claims reciting limitations similar to claims 1-10. Thus rejection of limitations are addressed in claims 1-10 above.

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Steelman, whose telephone number is (571) 272-3704. The examiner can normally be reached Monday through Thursday, from 7:00 AM to 5:30 PM If

attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Zhen can be reached at (571) 272-3708. The fax phone number for the organization where this

application or proceeding is assigned: 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be

directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mary Steelman

11/08/2006